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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/886,223 | 06/22/2001 | Preben Lexow | Q-64884 | 5556 |

7590 01/15/2003
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EXAMINER

WHISENANT, ETHAN C

ART UNIT PAPER NUMBER

1634

DATE MAILED: 01/15/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,223

Applicant(s)

LEXOW, PREBEN

Examiner

Ethan Whisenant, Ph.D.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-47 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-47 and 57-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-829)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Applicant's election of Group I (**Claims 26-47 and 57-60**) without traverse in Paper No. 8 (i.e. the paper(s) filed 21 OCT 02) is acknowledged. The restriction requirement has now been reconsidered, is deemed proper and is therefore, herein made **FINAL**. In addition, Claims 48-56 and 61-64 have been canceled as directed.

SEQUENCE RULES

2. This application complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

CLAIM OBJECTIONS

3. **Claim(s) 28** is/are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

35 USC § 112- 2ND PARAGRAPH

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH

5. Claims 26-47 and 57-60 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim(s) 26,28-31, 33 are indefinite because it is unclear what is intended by the phrase "correspond to" on line 13. it is unclear as to the type of correspondence intended. Does "correspond to" mean that one or more bases must be complementary to (i.e. able to hybridize) to the magnifying tag(s). This is how this phrase has been interpreted as this appears to be what is intended. Also note that the phrase "in proximity to" (Claim 1, line 15) is a relative term which makes the claim indefinite because the skilled artisan would be unable to determine the metes and bounds of the claimed invention. Please clarify.

35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that may form the basis for rejections set forth in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in --

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)

Claim Rejections under 35 USC § 102

7. Claim(s) 57-58 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Brenner et al [US 6,150,516 (2000)].

Claim 57 is drawn to a kit comprising at least one or more adapter molecules as defined in Claim 26 which states that an adapter molecule comprises one or more magnifying tags or a means for attaching one or more magnifying tags wherein said magnifying tag(s) correspond to one or more bases of the adapter binding region or to one or more bases in proximity to the adapter binding region.

Claim 58 is drawn to an embodiment of the kit of Claim 57 wherein said adapter molecules are attached to one or more solid supports.

Brenner et al. teach a kit comprising at least one or more adapter molecules as recited in Claims 57-58 and as defined above (i.e. as defined in Claim 26). See for example Claim 1.

8. Claim(s) 57 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Brenner [US 5,552,278 (1996)].

Claim 57 is drawn to a kit comprising at least one or more adapter molecules as defined in Claim 26 which states that an adapter molecule comprises one or more magnifying tags or a means for attaching one or more magnifying tags wherein said magnifying tag(s) correspond to one or more bases of the adapter binding region or to one or more bases in proximity to the adapter binding region.

Brenner et al. teach a kit comprising at least one or more adapter molecules as recited in Claims 57 and as defined above (i.e. as defined in Claim 26). See for example Column 15, beginning at about line 47.

ALLOWABLE SUBJECT MATTER

9. Claims 26 and its dependents would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action. The closest prior art discovered during the search was DuBridge [US 5,888,737 (1999)]. However, this reference alone or in combination with the

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other prior art cited does not teach or reasonably suggest the method of magnifying a signal associated with one or more bases of sequence in a target nucleic acid molecule as recited in Claim 26.

CONCLUSION

10. Claim(s) 26-47 and 57-60 is/are rejected and/or objected to for the reason(s) set forth above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



Ethan Whisenant, Ph.D.
Primary Examiner